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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/064,327 | 07/02/2002 | Georg K. Blaschke | 20043 | 8285 |

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SRAM CORPORATION
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EXAMINER

KIM, CHONG HWA

ART UNIT PAPER NUMBER

2167

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 12/18/2006 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/064,327

Applicant(s)

BLASCHKE, GEORG K.

Examiner

Chong H. Kim

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Nov 16, 2006 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, and 4-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Zaltron, U.S. Patent 6,898,824 B2.

Zaltron shows, in Figs. 1-7, a twistshifter comprising a housing element 5 mounted; an actuating element 2 being rotatable, the actuating element having a limited angle of rotation; a locking device 9, 10, 12 including a first latching element 9, 10 arranged on the housing element and a second latching element 12 having a complementary shape for engagement with the first latching element and arranged directly on the actuating element, the second latching element

Art Unit: 2167

having a hook contour extending along a segment of a circumference of the twistshifter and the first latching element forming a cutout 14 having a complementary shape to the hook contour and extending through the housing element, wherein deformable disengagement of at least one of the first and the second latching elements permits disengagement of the actuating element from the housing element, the locking device defining the limited angle of rotation of the actuating element; wherein the first and second latching elements are arranged at a radius of the twistshifter; wherein the first and second latching elements extend along two segments of a circumference of the twistshifter, the segments defining angles of different sizes; wherein the difference between the angles of the segments of the latching elements corresponds to a maximum angle of rotation of the actuating element; wherein the hook latching element is arranged on the actuating element; and a chamfer 13 extending along a segment of the circumference of the twistshifter having an angle corresponding to an angle of the segment of the hook latching element.

(Note: The handlebar recited in the claims is not given patentable weight since the handlebar is only recited for intended use. Furthermore, the wherein clause, as amended, in lines 12-15, is not given patentable weight since the limitation does not limit the scope of the claimed end product, but rather states what the end product can do during the use/disassembly. See MPEP 2106, II, C. Moreover, such clause can be viewed as a process limitation in a product claim. Although it is permitted, the process limitation in a product claim is not given a patentable weight. See MPEP 2113)

Response to Arguments

4. Applicant's arguments filed Nov 16, 2006 have been fully considered but they are not persuasive. The applicant argues that Zaltron fails to show the disengagement by deformation. First, it is stated in MPEP 2106 (II) (C) that "(l)anguage that suggests or makes optional but does not require to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation." The wherein clause, as amended, in claim 1 recites what the end product, in this case a twistshifter, can do during the disassembly. Such performance does not limit the scope of the end product claim. Second, such clause also can be interpreted as a process limitation. MPEP 2113 describes that a process recitation is allowed in a product claim. However, such process limitation is not given a patentable weight. Third, for an argument sake, assuming that the wherein clause is given a patentable weight, the recitation states that the one of the elements are deformed to permit disengagement of the actuating element from the housing element. It appears that the reference of Zaltron shows such limitation. It is certain that if the element 12 is deformed, i.e. by a force or by a natural decaying process, then such deformed element permits disengagement of the actuating element from the housing element. Therefore, Zaltron meets the anticipation requirement of USC 102.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2167

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chong H. Kim whose telephone number is (571) 272-7108. The examiner can normally be reached on Monday - Friday; 9:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cottingham can be reached on (571) 272-7079. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2167

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

chk
December 12, 2006


CHONG H. KIM
PRIMARY EXAMINER